

## REMARKS

### STATUS OF CLAIMS

No claims have been cancelled, amended, added, or withdrawn.

Claims 1, 2, 4, 6, 10, 12, 15, 16, 20, 23, 24, 31, 34, 38, 42, 47, 48, 51, 54-56, and 59-101 are currently pending in the application.

### SUMMARY OF THE REJECTIONS OF THE CLAIMS

Claims 1, 2, 4, 6, 10, 12, 15, 16, 20, 23, 24, 31, 34, 38, 42, 47, 48, 51, 54-56, and 59-101 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent Application Publication Number 2003/0044017 6,240,188 of Briscoe ("*Briscoe*"). The rejections are respectfully traversed.

### IDENTIFICATION OF CLAIMS IN 102(e) REJECTION

As a preliminary administrative matter, the Final Office Action lists the following claims at the start of the 102(e) rejection (e.g., item 7 on page 3 of the Final OA): Claims 1, 2, 4-6, 9-32, 34, 35, and 38-58. This listing of claims appears to be intended to be a listing of all pending claims in the Application, since no other rejections are identified, nor are any claims identified as being allowable over the prior art.

The correct listing of all pending claims is in the Final Office Action in item 2 on page 2, on the Office Action Summary sheet, and on the continuation sheet following the Office Action Summary sheet. Also, the individual rejections and citations of the claims matches the list of pending claims and not the listing of the claims at the start of the 102(e) rejection. Therefore, since it appears to the Applicant that the Final Office Action intended to reject all pending claims in the 102(e) rejection, the Applicant is proceeding on that basis as if all the pending claims as listed in those three locations were instead listed at the start of the 102(e) rejection. However, if this is incorrect, the Applicant respectfully requests clarification in the next communication from the Office.

#### **A. *BRISCOE* DOES NOT QUALIFY AS PRIOR ART UNDER 102(e)**

##### **(1) THE FILING DATE OF THE APPLICANT'S APPLICATION**

The filing date of the Applicant's Application is November 30, 2000, and as indicated on the Official Filing Receipt, the Applicant has claimed priority for the present Application

as a Continuation-In-Part (CIP) to a number of previously filed applications with filing dates of September 10, 1999, September 29, 1999, and December 22, 1999.

However, for purposes of simplifying the following discussion, the Applicant will use the actual filing date of the present Application, namely **November 30, 2000**, as the Applicant's filing date for purposes of determining whether *Briscoe* qualifies as prior art because the following discussion and conclusions are not altered even if one of the other priority dates are used in place of the actual filing date. However, this assumption should not be construed as an admission by the Applicant that all of the claims of the present Application are not entitled to each one of the filing dates of the applications to which priority is claimed.

(2) PRIORITY HISTORY AND RELEVANT DATES FOR *BRISCOE*

The cited prior art reference of *Briscoe* is a U.S. Patent Application Publication No. 2003/0044017 A1, **published March 6, 2003**, of U.S. Patent Application No. 10/019,012, which was **filed on December 26, 2001**, per information from PAIR (e.g., *Briscoe*'s "Filing or 371(c) Date" is given in PAIR as "12-26-2001").

*Briscoe* is a U.S. National Stage Application of a PCT application filed in Great Britain, specifically PCT Application No. PCT/GB00/02813, which was **filed on July 20, 2000**, which is *Briscoe*'s "**International Filing Date**," and which was published as WO/2001/008348 on **February 1, 2001**.

Next, *Briscoe*'s corresponding PCT/International Application claims priority to European Patent Application, No. 99305870.0, which was **filed on July 23, 1999**, and which was **published on February 7, 2001**.

Note that on the cover of U.S. Patent Application Publication No. 2003/0044017 A1, item 22 for "PCT Filed" is incorrectly given as "Jul. 20, 2001" when in fact the PCT Filed date is actually "Jul. 20, 2000." The PCT filing date of July 20, 2000 is consistent with the 1-year period for claiming priority to the European application that was filed on July 23, 1999 (e.g., if July 20, 2001 were the correct PCT filing date, then the PCT application of *Briscoe* could not claim priority to the European application since more than 1 year would have passed). Also, since the PCT application was published on February 1, 2001, the PCT application could not have been filed on July 20, 2001, since that would be more than six months *after* the publication date of the PCT application, and a PCT application obviously cannot be published before it is filed. Finally, the PCT application number includes the year

as part of the second portion (e.g., the “00” in “GB00”), which denotes that the PCT application was filed in Great Britain in 2000, not 2001. Thus, the correct *PCT filing date* for *Briscoe* is July 20, 2000, not July 21, 2001 as indicated on the cover of *Briscoe*.

Finally, note that given the filing date of the Applicant’s Application of November 30, 2000, the only dates from *Briscoe*’s priority history that would antedate the Applicant’s filing date are *Briscoe*’s European Application’s filing date of July 23, 1999 and *Briscoe*’s PCT Application’s filing date of July 20, 2000. All of the other dates given above, which includes all the publication dates (e.g., in Europe, by WIPO, and by the U.S.) and the U.S. national stage entry date, are after the Applicant’s filing date of November 30, 2000.

(3) THE EFFECTIVE DATE OF A REFERENCE UNDER 102(e) PER MPEP 706.02(f)(1)

MPEP §706.02(f)(1) provides “Examination Guidelines for Applying References Under 35 U.S.C. 102(e)” that addresses how to determine the appropriate 35 U.S.C. 102(e) date, if any, for a potential reference.

Step (A) of MPEP §706.02(f)(1) states: “The potential reference must be a U.S. patent, a U.S. application publication (35 U.S.C. 122(b)) or a WIPO publication of an international application under PCT Article 21(2) in order to apply the reference under 35 U.S.C. 102(3).” Because *Briscoe* U.S. Patent Application Publication No. 2003/0044017 A1 is a published U.S. patent application, the Applicant does not dispute that *Briscoe* meets this requirement of step (A) of MPEP §706.02(f)(1).

Next, step (B) of MPEP §706.02(f)(1) states: “Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (C) below.” Since *Briscoe* U.S. Patent Application Publication No. 2003/0044017 A1 claims priority to PCT Application No. PCT/GB00/02813, which is an international application, the analysis under MPEP §706.02(f)(1) proceeds to step (C).

Next, step (C) of MPEP §706.02(f)(1) states: “If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

- (1) If the international application meets the following three conditions:
  - (a) an international filing date on or after November 29, 2000;
  - (b) designated the United States; and
  - (c) published under PCT Article 21(2) in English,

then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e)....

- (2) If the international application was filed on or after November 29, 2000, but did **not** designate the United States or was **not** published in English under PCT Article 21(2), do **not** treat the international filing date as a U.S. filing date for prior art purposes...
- (3) If the international filing date has an international filing date prior to November 29, 2000, apply the reference under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments:
  - (a) For U.S. patents... [not applicable as *Briscoe* is a published application, not a patent]
  - (b) For U.S. application publications and WIPO publications directly resulting from international applications under PCT Article 21(22), never apply these references under 35 U.S.C. 102(e). These reference may be applied as of their publication dates under 35 U.S.C. 102(a) or (b);
  - (c) For U.S. application publications of applications that claim the benefit under 35 U.S.C. 120 or 365(c) of an international application filed prior to November 29, 2000, apply the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.” (Emphasis in original.)

Note that the analysis under MPEP §706.02(f)(1) reflects a requirement not found in the text of 102(e) itself, ***namely the filing date of the International Application (IA)***. Per Section 102(e), a person shall be entitled to a patent unless “the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language...” Thus, the language of 102(e) itself fails to mention anything about the International Application (IA) having to be filed after November 29, 2000, to apply under 102(e).

However, as explained in the “Examination Guidelines for 35 U.S.C. § 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. § 102(g) (Revised<sup>1</sup>),” a copy of which can be found at the U.S. PTO website at [www.uspto.gov/web/offices/pac/dapp/opla/preognotice/102eog121102.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/102eog121102.pdf), which has been subsequently incorporated into MPEP §706.02(f)(1), under item “A. Effective Date Provisions of the Amendments” following the heading “SIGNIFICANT PROVISIONS:” states in relevant part: “The **filing date of the application** is no longer relevant in determining what version of § 102(e) to apply in determining the patentability of that application, or the patent resulting from that application. The revised statutory provisions supercede all previous versions of §§ 102(e) and 374, with only one exception, which is when the potential reference is filed based on an international application **filed prior to November 29, 2000** (discussed further in section D below.)” (Emphasis added.)

Thus, while the filing date of the Applicant’s Application is not relevant to the determining which version of 102(e) to apply, the filing date of the International Application (IA) is relevant in order to determine whether the current version of 102(e) is to be applied, or whether the pre-AIPA version of 102(e) is to be applied.

Section D then states: “**D. International filing dates prior to November 29, 2000 cannot be used under § 102(e) for prior art purposes....**No international filing dates prior to November 29, 2000 may be relied upon as a prior art date under § 102(e) in accordance with the last sentence of the effective date provisions...” This is consistent with MPEP § 706.02(f)(1) above, in which it can be seen that no benefit is realized from the filing date of an International Application (IA) that is filed before November 29, 2000. Rather, the only date that a reference has under 102(e) is based on the U.S. filing date or 371 date. Of course, there may be a prior art date under 102(a) or (b) based on a publication date.

#### (4) THE EFFECTIVE DATE OF *BRISCOE* UNDER 102(e)

The sections of the MPEP quoted above apply because *Briscoe*, as U.S. Published Patent Application 2003/0044017 A1, claims the benefit of the international application filed in Great Britain, namely PCT/GB00/02813. Note that the European Application filed on July 23, 1999, is irrelevant for this analysis since that European Application is not an International Application (and even if the European application were considered to be an

international application, the European Application cannot designate the U.S. and thus would fail to qualify as prior art under 102(e)).

However, subsections (1) and (2) under step (C) of MPEP § 706.02(f)(1) do not apply to *Briscoe* because the international filing date to which *Briscoe* claims priority is before November 29, 2000, namely the filing date of *Briscoe* PCT/GB00/02813 is July 20, 2000, which is before November 29, 2000. Thus, *Briscoe* U.S. Published Patent Application No. 2003/0044017 A1 does not use the international filing date (e.g., July 20, 2000) as the U.S. filing date for prior art purposes under 35 U.S.C. 102(e).

Instead, the analysis continues to section (3) under step (C) of MPEP § 706.02(f)(1) because the international filing date has an international filing date prior to November 29, 2000 (e.g., the filing date of *Briscoe* PCT/GB00/02813 is July 20, 2000, which is before November 29, 2000). Thus, the analysis must apply the reference under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments as given above per sub-sections (a), (b), or (c) of section (3) under step (C) of MPEP § 706.02(f)(1).

In this case, neither subsection (a) nor (b) applies (e.g., *Briscoe* is neither a U.S. patent, because it is a U.S. Published Patent Application, nor did *Briscoe* result directly from the international application).

Rather, **subsection (c)** under step (C) of MPEP § 706.02(f)(1) **is the applicable subsection** here in this analysis, which means that *Briscoe* U.S. Published Patent Application No. 2003/0044017 A1 is applied under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application, which in this case is **December 26, 2001**.

Because the effective date of *Briscoe* under 35 U.S.C. 102(e) is December 26, 2001, which is after the Applicant's filing date of November 30, 2000, the Applicant respectfully submits that *Briscoe* U.S. Published Patent Application No. 2003/0044017 A1 does not qualify as prior art against the Applicant's Application.

Note that in MPEP § 706.02(f)(1), the situation of *Briscoe* matches the example on page 700-35, namely "Example 6: References based on the national state (35 U.S.C. 371) of an International Application filed prior to November 29, 2000..." Thus, *Briscoe's* PCT application filed in Great Britain is analogous to the International Application (IA) of Example 6 that is filed in Canada, both of which are before November 29, 2000. Thus, the 102(e) date for the reference in Example 6 is the date of National Stage entry date of

July 1, 2002, and therefore, the 102(e) date for *Briscoe* is also the National Stage entry date of December 26, 2001.

Also, the conclusions reached above can also be understood with reference to the Flowcharts of MPEP §706.02(f)(1), specifically the first flowchart on page 700-40. Starting in the top box, because *Briscoe* is not a U.S. application publication of an International Application, the answer is “No.” At the next box, because there is an IA in the continuity chain for which a benefit is sought, the answer is “Yes.” At the next box, because the IA was filed before, not “on or after,” November 29, 2000, the answer is “No.” Thus, because *Briscoe* is a U.S. application publication, the 102(e) date is the filing date of the U.S. application that claimed benefit to the IA.

(5) THE EFFECTIVE DATES OF *BRISCOE* UNDER 102(B)

Although *Briscoe*’s effective date under 102(e) is after the Applicant’s filing date, *Briscoe* also has potential effective dates under 102(b) as of any publication date. However, in this situation, all of *Briscoe*’s publication dates are after the Applicant’s filing date of November 30, 2000, namely – the U.S. publication date is March 6, 2003, the WIPO/IA publication date is February 1, 2001, and the European application publication date is February 7, 2001.

Therefore, the Applicant respectfully submits that *Briscoe* cannot qualify as prior art under 102(b) because none of the publication dates associated with *Briscoe* are before the Applicant’s filing date of November 30, 2000.

(6) CONCLUSION OF DISCUSSION OF *BRISCOE*

Because *Briscoe* has an effective date as prior art under 102(e) of December 26, 2001, which is after the Applicant’s Application filing date of November 30, 2000, because all of the possible effective dates for *Briscoe* as prior art under 102(a) or (b) are in 2001 or later, and because there are no other rejections in the Final Office Action after *Briscoe* is excluded as a prior art reference, the Applicant respectfully submits that Claims 1, 2, 4, 6, 10, 12, 15, 16, 20, 23, 24, 31, 34, 38, 42, 47, 48, 51, 54-56, and 59-101 allowable over the art of record and is in condition for allowance.

## CONCLUSION

The Applicant believes that all issues raised in the Final Office Action have been addressed and that allowance of the pending claims is appropriate. Entry of the amendments and further examination on the merits are respectfully requested.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

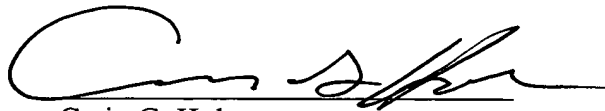
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

To the extent necessary to make this reply timely filed, the Applicant petitions for an extension of time under 37 C.F.R. § 1.136.

If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner for Patents, Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450.

on

July 5, 2006

by

Larry Reynolds